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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,913	08/08/2000	Sergei Mikhailovich Safronov	V-177	5275

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EXAMINER	
RADA, ALEX P	
ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/601,913	SAFRONOV ET AL.	
	Examiner	Art Unit	
	ALEX P. RADA	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/3/10*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17,21 and 23-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17,21 and 23-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to the amendment filed 3 March 2010 wherein applicant amends claim 21 and claims 17, 21 and 23-30 are pending in this application.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 21 is rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). *See* *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). *See also In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending). Claim 21 recites the method of playing a space game using the device for playing a space game, but the claim does not provide any type of machine or apparatus to perform the method of playing a space game. The claim as amended regarding the word actuation does not provide a method that requires a particular **machine or apparatus** such that the method cannot be performed mentally or manually in a manner that reasonably accomplishes the intended purpose of the recited invention, as claimed, without the use of a structure.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 21 recites the language of, "actuation of the device for playing a space game being a random number generator". If the space waste or debris is moving freely in space, then how can a device be actuated if the space waste is randomly moving in space. The term actuation may be interpreted to be toggling or pressing of a switch. The definition of the word actuate is defined as: to make active; cause to function or act. How does the freely moving space waste become active, to cause to function or act when the space waste is already moving freely in space. The disclosure does not describe, teach nor discuss the actuation of the device for playing a space game being a random number generator.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: The steps of how the game is actually played are not provided and cannot be

determined. The method does not provide **steps** of how the space game is actually played. How is the RNG used as part of playing the game? What role does the RNG play in the actual play of the game?

Claim 21 recite the language of, actuation of the device for playing a space game being a random number generator. How does the freely moving space waste become active (actuated), to cause to function or act when the space waste is already moving freely in space.

Claim 21 recites the limitation "the device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 17 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (JP 05-286500) in view of Carlin (US 4,763,284)

Kitazawa discloses the use of satellites (space vehicle) randomly moving in space outside the Earth observes and catches some space debris (game elements), an event assessment means (device 3) located within the satellite body and having a set of fields (detecting sensors 2) reliably separated from each other and provided with identification markers (drawings 1-2, 4; wherein each of the sensors on the satellite body are the identification markers), and a technical facility, wherein the set of debris detecting sensors (2) transmit the detection signal to the device (3) to detect the hitting of

the set of fields by the elements in some moment of time (space debris) located on board the space vehicle (satellite), and sensors generating signals to indicate collision on the game fields, along with information about exact game field identification marker and time of collision (device 3; wherein the device 3 has a recorder for recording information and/or communication, which is understood to record data (which may include time) regarding which sensor(s) on a particular part or section of the satellite that was activated. The satellites in Kitazawa, in its broadest reasonable interpretation, is the space vehicle; the game elements, in its broadest reasonable interpretation, is the space debris; the game event assessment means, in its broadest reasonable interpretation, is the device or equipment (3), the technical facility for registering a game event, in its broadest reasonable interpretation is the debris detecting sensors, which is located outside the earth (2) transmit the detection signal to the device (3) to detect the hitting of the set of game fields by the elements (space debris) located on board the space vehicle (satellite).

Kitazawa is silent in regards to generating signals about collisions to mark the identification marker and the exact time of collisions and the telemetry channel for transmitting the game event occurrence data outside the earth and a technical facility on the earth receiving and deciphering the telemetry signal, the technical facility including a computer receiving, processing and outputting results from the deciphered telemetry signal..

Carlin teaches a system that records the data of occurrence and relative time of each punch by a boxer and displays the results of each impact of the punch. A sensor(s) in each of the gloves activates when the sensor within each of the gloves is impacted and displays the magnitude, relative time and location to determine the force and time delivered by a sporting participant. Wherein the broadest reasonable interpretation of the generating signals, is the boxing gloves having the sensors; the broadest reasonable interpretation of identification marker and time of collision, is the displayed

impact of the boxing glove impacting (collision) on the opposing opponent with the measured reading on the display. Carling also discloses a computer system to decode the signals for each signal generated by the sensors upon impact (collision) on the opposing opponent. By taking a known system of determining the time of impact and identifying the impact on a display and combining the concept to a device for play in space, one of ordinary skill in the art would yield predictable results of identifying the results of each contact, collision, force, blow, etc. to determine different outcomes, effects or results dependent upon the particular sporting event or occasion. Examiner takes official notice of the fact that telemetry is conventionally employed in the satellite art to provide data concerning a satellite's condition and events occurring on a satellite to the control station on earth. The signals coming from the satellites are received by the control station as ones and zeros which are then deciphered by a computer to determine the results, outcome, status or the like of the received signal. For example, in the movie Armageddon or the Apollo 13 incident, where the communications being transmitted from the satellites, space shuttle, capsule, space station or the like to the control station on earth. Kitazawa discloses a recorder for recording information and/or communication equipment, which is understood to relay information back and forth. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kitazawa to include a telemetry channel and technical facility in order to follow standard practice in the industry by providing data concerning a satellite's condition and events occurring on a satellite to the control station on earth.

Regarding claim 23, Carlin teaches a display for displaying at least a portion of the outputted results (figure 1; wherein the results of the impacts displayed on a monitor shown).

Regarding claim 24, Carlin teaches the display is a computer monitor (figure 1; wherein computer monitor is shown).

Regarding claims 25-26, at the time the invention was made, it would have been an obvious design choice to a person of ordinary skill in the art to provide a display comprising a television receiver and/or a radio receiver because Applicant has not disclosed that having a display comprising a television receiver and/or a radio receiver provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the display device of Carling because the display would provide the same function of displaying information.

9. Claims 21 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (JP 05-286500) in view of Carlin (US 4,763,284) and Dire et al. (US 4,756,531)

Regarding claim 21, Kitazawa in view of Carlin discloses the claimed invention incorporated herein as discussed above regarding the device of playing a space game. Kitazawa in view of Carlin are silent in regards to providing gamblers with options to make bets on forecasts in which time span and with which identified game fields the collisions of the game elements will be registered by the outputted results and determining winners and paying off the prizes in accordance with bets made.

Regarding claim 27, Carlin teaches a display for displaying at least a portion of the outputted results (figure 1; wherein the results of the impacts displayed on a monitor shown).

Regarding claim 28, Carlin teaches the display is a computer monitor (figure 1; wherein computer monitor is shown).

Regarding claims 29-30, at the time the invention was made, it would have been an obvious design choice to a person of ordinary skill in the art to provide a display comprising a television receiver and/or a radio receiver because Applicant has not disclosed that having a display comprising a television receiver and/or a radio receiver provides an advantage, is used for a

particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the display device of Carling because the display would provide the same function of displaying information.

Dire et al. (hereafter Dire) teaches gaming apparatus that provides gamblers options to make bets on numbers chosen by the player (forecast) in which the current game play (time span) and with which numbers picked by the user will be identified on the grid (62) of the gaming apparatus which identifies the numbers on the grid (game fields collisions of the game elements will be registered) by the outputted results chosen by the player in determining the correct number of chosen spots and paying off the prizes in accordance with the bets made. Dire further discloses a display for displaying the outputted results such as a computer monitor. Dire teaches the basic concept of a player selecting the appropriate number of spots and placing a wager and based on a random number generator to determine random spots and a player is awarded on the number of spots that match the random number generator spots. The concept of playing wagers on and type of sporting and non-sporting event are well known in the art. The different and non-conventional wagering is called propositional betting which provides gamblers with an immediate but short-lasting buzz of action. The substitution of known elements of space debris with a random number generator, the game fields with the number of areas/spots for the player to choose from, and the technical facility with the computer process to determine the results of outcome to determine a winner and award would have been obvious to one of ordinary skill in the art at the time of the invention since the substitution of space debris with a random number generator, the game fields with the number of areas/spots for the player to choose from, and the technical facility with the computer process to determine the results of outcome to determine a winner and award in the combined prior art of Kitazawa in view of Carlin and Dire would have yielded predictable results of providing different

type of proposition wagering to attract players to play a familiar game of keno or lottery type game but on a bigger scale.

Response to Arguments

10. Applicant's arguments filed 3 March 2010 have been fully considered but they are not persuasive.

Applicant contends that applicant's invention is a Random Number Generator (RNG) specifically dedicated to playing a space game. Applicant noted that several patents were granted based on RNG application similar by structure to the applied invention and based on the stochastic character of different natural process.

The examiner respectfully disagrees. The claimed invention does not disclose the RNG application similar by structure to the applied invention and based on the stochastic character of different natural process. The cited references to the natural stochastic process are all electrical type generating processes that are man made. The space waste moving outside the earth is not man made, meaning the space waste are moving freely outside the earth without any help from electrical/electronic type device. How does the space waste moving freely used as a RNG? The claimed limitation doe not clearly provide, show or provide steps of how RNG is and accomplished by the claimed invention. The examiner request applicant to point in the disclosure the support for the applicant's argument regarding the stochastic characteristic. Applicant argues the stochastic characteristic process, however the noted feature is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. As discussed in the previous office action, Kitazawa discloses structurally applicants claimed invention as discussed above. As noted in MPEP 2114 a claim containing a recitation with

respect to the manner in which the claimed apparatus intended to be employed does not differentiate the claimed apparatus from the prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. While features of Kitazawa are recited structurally, applicant's claims are directed to an apparatus that is not distinguished from the prior art in terms of structure rather than function. The only indication that claimed invention is a game is in the preamble. The body of the claim does not provide elements, rules procedures of an actual game play. The examiner has provided the broadest reasonable interpretation to applicant's claimed invention and references disclosing and/or teaching product appearing to be substantially similar in applicant's claimed invention. The burden shifts to the applicant to show the unobvious differences.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX P. RADA whose telephone number is (571)272-4452. The examiner can normally be reached on Monday - Thursday, 09:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P. R./
Examiner, Art Unit 3714

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714